

## Remarks

In the Office Action dated December 23, 2004, the Examiner rejected claims 1-4, 6-14, 16-23, 25-33, and 35-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,421,711 to Blumenau et al. ("Blumenau") in view of U.S. Patent No. 6,625,747 to Tawil et al. ("Tawil") and allowed claims 5, 15, 24 and 34.

### I. The Rejections under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-4, 6-14, 16-23, 25-33, and 35-39 under 35 U.S.C. § 103(a) as unpatentable because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8<sup>th</sup> Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8<sup>th</sup> Ed. 2001), pp. 2100-122 to 127.

Blumenau either alone or in combination with Tawil, fails to disclose or suggest the combination of features recited in independent claims 1, 11, 21 and 30.

Regarding independent claims 1, 11, 21 and 30, the Examiner asserts that Blumenau "teaches graphically displaying source device...; graphically displaying target

device (col. 29, lines 15-57; fig. 30); [and] displaying a first data path between source device and target devices..." (See Office Action, page 2.) The Examiner admits that "Blumenau does not teach [the element of] in response to a failure in the first data path," and, as indicated by the Examiner's discussion of Tawil, "graphically indicating the failure in the first data path; and graphically displaying a failover data path." In an attempt to compensate for these shortcomings, the Examiner relies on Tawil, asserting that the reference teaches "in response to a failure in the first data path: graphically indicating the failure in the first data path; and graphically displaying a failover data path[.] ([C]ol. 6, lines 5-16)." (See Office Action, page 2.) Applicants respectfully disagree.

As explained in the Response filed August 26, 2004, Tawil does not compensate for the admitted shortcomings of Blumenau. For example, Tawil discloses a system for handling computer storage system failovers. The system uses multiple storage controllers that share a common node name to allow a host system to virtually see these two controllers as a single unit. Tawil, however, does not teach or suggest graphically displaying a first data path between source and target devices and graphically indicating a failure in the first data path and displaying a failover path, as asserted by the Examiner. Indeed, Tawil does not teach or even suggest graphically displaying any type of device or component or status thereof. Although the Examiner is correct in stating that Tawil teaches a communication path (i.e., element 28), the Examiner stops short of addressing the actual recitations of Applicants' claimed invention. Tawil does not teach "displaying a failover path" in col. 6, lines 5-16. These portions of the reference cited by the Examiner merely describe the failover techniques

used by Tawil to reroute data communications between storage controllers, and do not teach or suggest graphically displaying any type of device or data path, as alleged by the Examiner.

In attempting to address the above arguments, the Examiner asserts that “Blumenau and Tawil modify together to perform a method and system of indicating a failover data path in a graphical user interface for virtual ports (for a cached storage subsystem in a system which includes data network and hosts (user)).” (See *Office Action*, page 6, ¶ 6.) In particular, the Examiner asserts that Blumenau teaches “indicating the failure condition between the network and the hosts and using graphical user interface to display those volumes which are not allocated to any host.” (*Id.*). Further, the Examiner asserts, “Tawil teaches using controller to perform failover operations if the signal path fails (the failure condition of the signal path).” (*Id.*).

The user interface disclosed by Blumenau is used by an administrator to set up the relationship between logical storage volumes of a storage subsystem and the volumes addressed by a host. The administrator uses the interface to display properties associated with each of the volumes, which may include port and path identifications. (See Blumenau, col. 29, line 18 to col. 30, line 12.) The reference, however, does not disclose or even suggest graphically displaying a source and target device, displaying a first data path between source device and target devices, and graphically indicating a failure in the first data path and a failover data path, as asserted by the Examiner. Further, as indicated by the Examiner, Tawil merely discloses a failover controller system to compensate for failed signal paths. This reference does not

disclose or even suggest displaying any type of failover data paths, much less data paths between graphically displayed devices, as alleged by the Examiner.

In spite of these deficiencies, however, the Examiner maintains the position that the cited art suggests such features without pointing to any actual teaching within the references themselves. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Examiner has not shown that a skilled artisan considering Blumenau and Tawil, and not having the benefit of Applicants’ disclosure, would have been motivated to combine or modify the references in a manner resulting in Applicants’ claimed combination. Instead, the Examiner merely concludes the cited art “modify together to perform [a] method and system of indicating a failover data in a graphical user interface” based on references that do not actually teach the features that make up the alleged combination. This conclusion is not properly supported by the references themselves and does not show that a skilled artisan would have combined the references as alleged. The mere fact that Blumenau mentions a graphical user interface that displays volumes and the relationships between them and Tawil discloses a system that performs failover processes does not show that a skilled artisan would have been motivated to modify the cited art as alleged.

The M.P.E.P. makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” M.P.E.P. 2145.01 (citations omitted). The Examiner has not shown that the cited art “suggests the desirability” of the alleged combination.” Indeed, there is no reason why a skilled artisan would look to modify the cited art to graphically indicate a failure in a data path and a failover data path without relying on Applicants’ own disclosure. As such, Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. For at least these additional reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claims 1, 11, 21 and 30, and thus, the rejection of these claims under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Claims 2-10 depend from claim 1. As explained, the cited art does not support the rejection of claim 1. Accordingly, the cited art does not support the rejection of dependent claims 2-10 for at least the same reasons set forth above in connection with the rejection of claim 1. Applicants therefore request that the rejection of claims 2-10 be withdrawn and the claims allowed.

The Examiner rejects claims 11-14, 16-23, 25-33, and 35-39 for the same reasons set forth for claim 1. (See *Office Action*, page 5.) As explained, the cited art does not support the rejection of claim 1. Accordingly, the cited art also does not support the rejection of dependent claims 11-14, 16-23, 25-33, and 35-39 for at least the same reasons set forth above in connection with the rejection of claim 1. Applicants

therefore request that the rejection of claims 11-14, 16-23, 25-33, and 35-39 be withdrawn and the claims allowed.

## **II. Allowed Claims 5, 15, 24, and 34**

Applicants thank the Examiner for allowing claims 5, 15, 24, and 34. The Examiner asserts in the reasons for allowance that “[t]he prior art does not teach ceasing the display of the first link; displaying a red-colored portion on the first link; displaying the first link using a broken line.” Claims 5, 15, 24, and 34, however, recite, among other things, “wherein said graphically indicating the failure in the first data path *comprises one of the group consisting of:* ceasing the display of the first link; display a red-colored portion on the first link; and displaying the first link using a broken line.” (Emphasis added.)

## **III. Conclusion**

Applicants respectfully request that this Response under 37 C.F.R. § 1.116 be considered by the Examiner, placing claims 1-4, 6-14, 17-23, 25-33, and 36-39 in condition for allowance. Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the cited art against the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

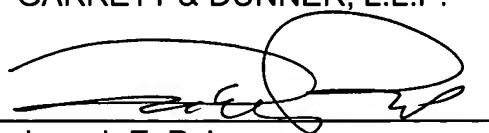
The Office Action contains numerous characterizations of the claims and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
Joseph E. Palys  
Reg. No. 46,508